

Remarks

Claim 76 is herein amended to correct clerical errors in this claim as amended in the Amendment submitted May 4, 2004. Support for the amendment is replete in the specification as originally filed. See Specification as filed, for example, p.1, line 7; p.2, line 18; and p.3, line 31. Claim 88 is herein amended to correct a clerical error in the claim as originally added in the Amendment submitted May 16, 2002. No new matter has been added, and no new material presented that would necessitate an additional search on the part of the Examiner.

Upon entry of this Response, claims 73-83, 85-100, 107-110, 112, and 129-131 are pending.

Claims 73-83, 85-91, 107-110, 112, and 129-131 comply with 35 U.S.C. §103(a)

In discussing the rejections under 35 U.S.C. §103(a) of claims in this case, Applicant refers to the *Manual of Patent Examining Procedure* (M.P.E.P.) §2141, which states that when applying 35 U.S.C. §103 four tenets of patent law must be adhered to:

(A) The claimed invention must be considered as a whole;

(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

(C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and

(D) Reasonable expectation of success is the standard with which obviousness is determined. M.P.E.P., §2141, p. 125 (8th Ed. Rev.3, August, 2005); *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). [emphases added]

Claims 73-83, 85-91, 107-110 and 112 comply with 35 U.S.C. §103(a)

The Office action on p. 4 rejects claims 73-83, 85-91, 107-110 and 112 under 35 U.S.C. §103(a) in view of Checco (U.S. patent number 5,859,898) in combination with Lovett (U.S. patent number 4,450,477) and Schussler et al. (U.S. patent number 4,150,254). Applicant respectfully traverses.

For the convenience of the reader prior to analyzing the cited references, Applicant here reviews the subject matter of independent claims 73 and 107.

Claim 73 is directed *inter alia* to a television messaging gateway for handling messages adapted for operating in conjunction with a messaging server, the television messaging gateway having: a message control interface adapted to couple to a messaging server to control at least one message having address information associating the message with at least one user, a video output module adapted to couple to a downstream network for outputting video frame signals on a television coupled to an addressable terminal with an input interface adapted to connect to an upstream network for receiving user input signals inputted using a telephone and logic for directing a message a message control interface and a video output module.

Claim 107 is directed *inter alia* to a method for handling messages using a telephone, that involves inputting commands to a television messaging gateway to select at least one message directed to a user causing the television messaging gateway to output messages to a television set associated with the user.

In other words claims 73 and 107 as a whole are directed to an invention that is used by a person sitting and watching television, to automatically receive an email or a telephone call on the television.

As a preliminary matter, the Supreme Court in *Graham v. John Deere*, 383 U.S. 1 provided an analytical construct to be used when determining whether claims are obvious under 35 U.S.C. §103(a) in view of the prior art. One aspect of this analytical construct includes characterizing each cited reference, as a background for a legal analysis, prior to analyzing the combination of the references.

Checco (U.S. patent number 5,859,898)

Checco shows a message system that includes voice or data messages that are retrieved at the convenience of the recipient and a user can leave a message without being a subscriber. *Checco*, Abstract, lines 1-3, column 8, line 58. *Checco*'s message system for voice or data messages responds to message retrieval requests from a telephone, a computer or a fax machine. *Checco*, column 6, lines 35-45. In responding to a request, *Checco*'s system determines the communications format of the request, viz., the telephone, the computer modem, or the fax. *Checco*, column 6, lines 63-65. Then the system requests a user id and password. *Checco* column 7, lines 21-23. After user id and password are entered, *Checco*'s system determines

whether the user id is a subscriber or is a secondary user. Ibid., lines 30-36. The subscriber gets a customer menu and the secondary user gets restricted access according to the user id. Ibid., lines 32-33 and 39-41. With no user id or password, the system restricts the user to uploading messages for subscribers. Ibid., lines 45-47.

Thus, Checco evaluated as a whole describes a system that accepts requests from multiple devices and data formats and restricts user access to content with user id and password combinations.

Nowhere does Checco teach or suggest a messaging control interface for controlling at least one message having address information associating the message with at least one user, a video output module adapted to couple to a downstream network for outputting video frame signals on a television coupled to an addressable terminal with an input interface adapted to connect to an upstream network for receiving user input signals inputted using a telephone and logic for directing a message between a message control interface and a video output module, to which claim 73 is *inter alia* directed. That is, nowhere does Checco teach or suggest a system for a person sitting and watching television to automatically receive an email or a telephone call on the television, in real time.

Nowhere does Checco teach or suggest a method for handling messages using a telephone, inputting commands to a television messaging gateway, to select at least one message directed to a user, causing messages or a message to be outputted to a television set associated with the user, to which claim 107 is *inter alia* directed.

In other words, nowhere does Checco teach or suggest a system with which a user can use a telephone to send an email, video or other message to a particular addressed terminal for display on a television.

Lovett (U.S. patent number 4,450,477)

Lovett shows a system that delivers selected information from data banks to individual cable television subscribers through the same system that brings them television programming and that can be displayed on unmodified television sets. Lovett, column 6, lines 26-36.

Lovett's system converts the digital information selected from the databank by the individual user to analog form and transmits that information on a unique frequency

corresponding to the particular subscriber's television set. Ibid, column 7, lines 61-66. Lovett shows a system in which the subscriber receives the selected information "[o]nly when the subscriber's television set is tuned to his dedicated UHF information channel." Lovett, column 14, lines 12-14.

Thus, Lovett's system evaluated as a whole shows the use of a unique UHF frequency for each subscriber as the operating principle by which the system supplies individualized content to subscribers.

Nowhere does Lovett teach or suggest a messaging control interface for controlling at least one message having address information associating the message with at least one user, a video output module adapted to couple to a downstream network for outputting video frame signals on a television coupled to an addressable terminal with an input interface adapted to connect to an upstream network for receiving user input signals inputted using a telephone and logic for directing a message between a message control interface and a video output module, to which claim 73 is *inter alia* directed. That is, nowhere does Lovett teach or suggest a system for a person sitting and watching television to automatically receive an email or a telephone call on the television, in real time.

Nowhere does Lovett teach or suggest a method for handling messages using a telephone, inputting commands to a television messaging gateway, to select at least one message directed to a user, causing messages or a message to be outputted to a television set associated with the user, to which claim 107 is *inter alia* directed. In other words, nowhere does Lovett teach or suggest a system with which a user can use a telephone to send an email, video or other message to a particular addressed terminal for display on a television.

Schussler et al. (U.S. patent number 4,150,254)

Schussler shows an operating device associated with a receiver for controlling television receiver functions such that the operating device establishes a connection with a remote text data bank, the accessory device and the outside telephone line permitting selected texts to be called up for display on a television receiver. See Abstract, Schussler et al. The operating device uses a telephone and line and/or an outside telephone line to connect to a remote text data bank from

which the operating device retrieves selected text for display on a television receiver. Schussler et al. column 2, lines 57-62.

The system transmits the text information at bit rates of 600 to 2400 bauds from a text data bank through a telephone connection line to a single television. Schussler column 2, lines 60-65.

Nowhere does Schussler teach or suggest a messaging control interface for controlling at least one message having address information associating the message with at least one user, a video output module adapted to couple to a downstream network for outputting video frame signals on a television coupled to an addressable terminal with an input interface adapted to connect to an upstream network for receiving user input signals inputted using a telephone and logic for directing a message between a message control interface and a video output module, to which claim 73 is *inter alia* directed. That is, nowhere does Schussler teach or suggest a system for a person sitting and watching television to automatically receive an email or a telephone call on the television, in real time.

Nowhere does Schussler teach or suggest a method for handling messages using a telephone, inputting commands to a television messaging gateway, to select at least one message directed to a user, causing messages or a message to be outputted to a television set associated with the user, to which claim 107 is *inter alia* directed. In other words, nowhere does Schussler teach or suggest a system with which a user can use a telephone to send an email, video or other message to a particular addressed terminal for display on a television.

Thus, evaluated as a whole, Schussler's is simply a use of telephone and television for downloading remote texts from a data bank.

### Legal Analysis

The ultimate determination of whether an invention would have been obvious under 35 U.S.C. §103(a) is a legal conclusion based on underlying findings of fact. *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000).

According to a summary of criteria in the M.P.E.P., "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of

ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." [emphasis added] M.P.E.P. §2142; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A recent decision by the U.S. Supreme Court, *KSR International Co. v. Teleflex Inc.* 550 U.S.\_\_\_\_ (2007), discusses criteria for showing a motivation to combine numerous prior art references in a determination that a claimed invention is obvious. The U.S. Supreme Court in *KSR* explained that "[t]here is no necessary inconsistency between the idea underlying the TSM [teaching, success, motivation] test and the *Graham* analysis." *KSR International Co.* 550 U.S.\_\_\_\_ at p. 15. In fact, the court explains "... it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the newly claimed invention does." *Id.*

This interpretation of *KSR International Co. v. Teleflex Inc.* is confirmed by Guidelines promulgated by the U.S. Patent and Trademark Office and published October 10, 2007 in the Federal Register (vol. 72, no. 195, pp. 57526-57535).

Applicant respectfully traverses the above rejection, and shows below that the facts of the case and the relevant case law indicate that the invention would not have been obvious to one of ordinary skill in the art at the time the application was filed because the underlying facts show that the criteria for a *prima facie* rejection have not been met.

#### Prior art fails to teach all the subject matter of the claims

As shown above, the M.P.E.P. states that to establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all the subject matter of the claim.

Checco as a whole describes a system accepts requests from multiple devices and data formats and restricts user access to content with user id and password combinations.

Nowhere does Checcho teach or suggest a messaging control interface for controlling at least one message having address information associating the message with at least one user, a

video output module adapted to couple to a downstream network for outputting video frame signals on a television coupled to an addressable terminal with an input interface adapted to connect to an upstream network for receiving user input signals inputted using a telephone and logic for directing a message between a message control interface and a video output module, to which claim 73 is *inter alia* directed.

Nowhere does Checcho teach or suggest a method for handling messages using a telephone, inputting commands to a television messaging gateway, to select at least one message directed to a user, causing messages or a message to be outputted to a television set associated with the user, to which claim 107 is *inter alia* directed.

Lovett shows a system that delivers selected information from data banks to individual cable television subscribers through the same system that brings them television programming and that is displayed on unmodified television sets. Lovett, column 6, lines 26-36.

Nowhere does Lovett teach or suggest a messaging control interface for controlling at least one message having address information associating the message with at least one user, a video output module adapted to couple to a downstream network for outputting video frame signals on a television coupled to an addressable terminal with an input interface adapted to connect to an upstream network for receiving user input signals inputted using a telephone and logic for directing a message between a message control interface and a video output module, to which claim 73 is *inter alia* directed.

Nowhere does Lovett teach or suggest a method for handling messages using a telephone, inputting commands to a television messaging gateway, to select at least one message directed to a user, causing messages or a message to be outputted to a television set associated with the user, to which claim 107 is *inter alia* directed.

Schussler shows an operating device that uses a telephone and line and/or an outside telephone line to connect to a remote text data bank from which the operating device retrieves selected text for display on a television receiver. Schussler et al. column 2, lines 57-62.

Nowhere does Schussler teach or suggest a messaging control interface for controlling at least one message having address information associating the message with at least one user, a video output module adapted to couple to a downstream network for outputting video frame signals on a television coupled to an addressable terminal with an input interface adapted to

connect to an upstream network for receiving user input signals inputted using a telephone and logic for directing a message between a message control interface and a video output module, to which claim 73 is *inter alia* directed.

Nowhere does Schussler teach or suggest a method for handling messages using a telephone, inputting commands to a television messaging gateway, to select at least one message directed to a user, causing messages or a message to be outputted to a television set associated with the user, to which claim 107 is *inter alia* directed.

One of ordinary skill in the art of messaging and computer programming would have known, at the time the invention was made, that displaying a message inputted by telephone to a television, as in the present claims, is not the same as Schussler's telephone to connect to a remote text data bank in order that an operating device may retrieve selected text data for display on a television receiver.

Most important, neither Lovett nor Schussler cures the defects of Checco. Therefore, the combination of Checco, Lovett, and Schussler fails to render obvious the subject matter of claims 73 and 107 because the prior art references when combined do not teach or suggest all of the subject matter of the claims, as required by M.P.E.P. §2142. Therefore a *prima facie* case of obviousness has not been made.

Claims 74-83 and 85-91 depend from claim 73, and incorporate all of the subject matter of claim 73 and contain additional subject matter. As the combination of Checco, Lovett, and Schussler et al. fails to render obvious the subject matter of claim 73, therefore claims 74-83 and 85-91 also are not obvious in view of Checco, Lovett, and Schussler et al., alone or in any combination.

Claims 108, 110, and 112 depend from claim 107, and incorporate all of the subject matter of claim 73 and contain additional subject matter. As the combination of Checco, Lovett, and Schussler fails to render obvious the subject matter of claim 107, therefore claims 108, 110, and 112 also are not obvious in view of Checco, Lovett, and Schussler et al., alone or in any combination.

Claim 109 depends from claim 108 and indirectly from claim 107, and incorporates all of the subject matter of claim 107 and contains additional subject matter. As the combination of Checco, Lovett, and Schussler fails to render obvious the subject matter of claim 107, therefore



claim 109 also is not obvious in view of Checco, Lovett, and Schussler et al., alone or in combination.

Therefore for these reasons Applicant respectfully requests withdrawal of rejection of claims 73-83, 85-91, 107-110 and 112 under 35 U.S.C. §103(a).

No motivation to combine references having different principles of operation

To establish that a claim does not comply with 35 U.S.C. §103(a) based on a combination of the elements disclosed in the prior art in the absence of any hindsight, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. M.P.E.P., §2143.01, p. 135; *In re Fulton*, 391 F.3d at 1200-01, 73 USPQ2d at 1145-46 (Fed. Cir. 2004). The teaching or suggestion, not merely to make the claimed combination, but also of a reasonable expectation of success, must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488; 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.* affirmed the legal principle that the mere fact that each element of a claimed invention could be found within the prior art does not render the claimed invention obvious. The court stated:

.... A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR International Co.* 550 U.S. \_\_\_\_ at p. 14

The M.P.E.P. states “[I]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” M.P.E.P. §2143.01, p. 138; *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In *In re Ratti*, 270 F.2d 810 (CCPA 1959), claims were directed to an oil seal having a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references showed an oil seal in which the bore engaging portion was reinforced by a cylindrical sheet metal casing. The prior art device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding that the “suggested combination of

references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate.” See M.P.E.P. §2143.01 citing *In re Ratti* 270 F.2d at 813.

Applicant shows below that there would have been no motivation to have combined Checco and Lovett to arrive at the subject matter of the present claims at the time the invention was made, because such a combination would have required a change in the principle of operation of Lovett.

Lovett’s cable television customers are assigned unique UHF television frequencies as a means of offering individualized content to each subscriber. Lovett column 7, lines 61-66. Factual analysis above demonstrates that Lovett’s method requires a unique frequency for each subscriber.

Factual analysis further demonstrates that Checco does not operate by assigning users unique UHF frequencies. Instead of unique UHF frequencies, Checco restricts user access to messages and other data by requiring user logins and passwords such that data is not available to all users. Checco column 7, lines 35-41.

As in *In re Ratti* in which the prior art required rigidity whereas the claimed invention required resiliency, Lovett describes a system that uses a unique UHF frequency television signal, whereas Checco’s system accepts multiple data formats and limits access with login and password combinations. To have combined these two references would have required a suggestion to eliminate Lovett’s assigning a user a unique UHF frequency, which is the central principle of operation in Lovett. To have combined Checco with Lovett would have required a change to Lovett’s principle of operation and instead to have assigned content by user login. Therefore, there would have been no motivation to have combined these references at the time the present invention was made, as such a combination would have required a change in the principle of operation of Lovett or Checco.

The combination of Checco, Lovett, and Schussler fails to render obvious the subject matter of claims 73 and 107 because the proposed modification or combination of the prior art would have changed the principle of operation of Lovett’s method. M.P.E.P. §2143.01, p. 138; *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Therefore for this reason also, a *prima facie* case of obviousness has not been made.

Claims 74-83 and 85-91 depend from claim 73, and incorporate all of the subject matter of claim 73 and contain additional subject matter. As the combination of Checco, Lovett, and Schussler et al. fails to render obvious the subject matter of claim 73, therefore claims 74-83 and 85-91 also are not obvious in view of Checco, Lovett, and Schussler et al., alone or in combination.

Claims 108, 110, and 112 depend from claim 107, and incorporate all of the subject matter of claim 73 and contain additional subject matter. As the combination of Checco, Lovett, and Schussler fails to render obvious the subject matter of claim 107, therefore claims 108, 110, and 112 also are not obvious in view of Checco, Lovett, and Schussler et al., alone or in combination.

Claim 109 depends from claim 108 and indirectly from claim 107, and incorporates all of the subject matter of claim 107 and contains additional subject matter. As the combination of Checco, Lovett, and Schussler fails to render obvious the subject matter of claim 107, therefore claim 109 also is not obvious in view of Checco, Lovett, and Schussler et al., alone or in combination.

For any of the above reasons, Applicant respectfully requests withdrawal of rejection of claims 73-92 and 107-112 under 35 U.S.C. §103(a).

Claim 92 complies with 35 U.S.C. §103(a)

The Office action on p. 9, paragraph 6, rejects claim 92 under 35 U.S.C. §103(a) in view of Checco (U.S. patent number 5,859,898) in combination with Lovett (U.S. patent number 4,450,477) and Schussler et al. (U.S. patent number 4,150,254), the primary references analyzed above, and further in combination with Wagner et al. (U.S. patent number 6,335,736). Applicant respectfully traverses.

For the convenience of the reader prior to analyzing the additional reference, Applicant here reviews the subject matter of independent claim 92.

Claim 92 is directed *inter alia* to the television messaging gateway of claim 73, and is further adapted to generate signals to display on a television screen a progress bar indicating relative progress of an audio or video message being delivered to a terminal. Thus, claim 92

depends from and incorporates all of the subject matter of claim 73 and contains additional subject matter.

Checco, Lovett, and Schussler are characterized above.

Wagner et al. (U.S. patent number 6,335,736)

Wagner as a whole, shows a graphical user interface (GUI) for a television set-top box which includes a web browser. See Wagner Abstract. The GUI generates menu screens that are superimposed over conventional television video images, so that the user can view browser graphics generated by the GUI while viewing television images in the background. Ibid.

Wagner shows an interface that provides animated on-screen notifications of the presence of interactive content, such as hypertext links to World Wide Web pages, that may be associated with television content currently being received. Ibid. Wagner specifies, “[a]s will be described below, the GUI includes features which provide relatively seamless transitions between viewing television and interactive content, and which enhance the overall viewing experience.”

[emphases added] Ibid., column 3, lines 14-18.

Nowhere does Wagner teach or suggest a messaging control interface for controlling at least one message having address information associating the message with at least one user, a video output module adapted to couple to a downstream network for outputting video frame signals on a television coupled to an addressable terminal with an input interface adapted to connect to an upstream network for receiving user input signals inputted using a telephone and logic for directing a message between a message control interface and a video output module, to which claim 73 is *inter alia* directed. In other words, nowhere does Wagner teach or suggest a system in which a person can use a telephone to control a message and send it to a particular addressed television, in real time, if the system of these claims is turned on.

The combination of Checcho, Lovett, and Schussler fails to render obvious the subject matter of claim 73 because the combination of prior art references does not teach or suggest all of the subject matter of the claims, as required by M.P.E.P. §2142. Claim 92 depends from claim 73, and incorporates all of the subject matter of claim 73 and contains additional subject matter. Wagner does not cure any of the deficiencies of Checcho in combination with Lovett and Schussler. Therefore a *prima facie* case of obviousness has not been made.

As the combination of Checco, Lovett, and Schussler et al. fails to render obvious the subject matter of claim 73, therefore claim 92 also is not obvious in view of Checco, Lovett, Schussler et al., and Wagner alone or in any combination.

For any of the above reasons, Applicant respectfully requests withdrawal of rejection of claim 92 under 35 U.S.C. §103(a).

Claims 93, 99, and 129-130 comply with 35 U.S.C. §103(a)

The Office action on page 9, paragraph 7 rejects claims 93, 99, and 129-130 under 35 U.S.C. §103(a) in view of Krisbergh et al. (U.S. patent number 5,138,649, hereinafter Krisbergh '649) in combination with Krisbergh et al. (U.S. patent number 5,999,970, hereinafter Krisbergh '970). Applicant respectfully traverses the rejection.

For the convenience of the reader prior to analyzing the cited references, Applicant here reviews the subject matter of present pending independent claims 93 and 129.

Claim 93 herein is directed *inter alia* to a television messaging gateway for handling messages, operating in conjunction with a television distribution system having a downstream network carrying signals to a plurality of terminals, an upstream network constructed to deliver user input signals, the television gateway comprising a message control interface responsive to input signals for controlling at least one message having address information to associate the message with at least one user and an output module adapted to generating video frame signals corresponding to the message and constructed to deliver the signal to a terminal corresponding to the address information for display on a television set coupled thereto wherein the message control interface is constructed to control the message responsive to user input signals entered via telephone. That is, claim 93 is directed to a television messaging gateway with which a user can use a telephone to send an email, video or other addressed message to a particular addressed terminal for display on a television.

Claim 129 is directed *inter alia* to a system for handling messages, operating in conjunction with a television distribution system having a downstream network carrying signals to a plurality of terminals, an upstream network constructed to deliver user input signals, the television gateway comprising a message control interface responsive to input signals for controlling at least one message having address information to associate the message with at

least one user and an output module adapted to generating video frame signals corresponding to the message and constructed to deliver the signal to a terminal corresponding to the address information for display on a television set coupled thereto wherein the message control interface is constructed to control the message responsive to user input signals entered via telephone. That is, claim 129 is directed to a system with which a user can use a telephone to send an email, video or other addressed message to a particular addressed terminal for display on a television.

Below, Applicant characterizes the cited references as a background for a legal analysis.

Krisbergh et al. (U.S. patent number 5,138,649)

Krisbergh '649 shows a portable telephone handset in combination with a remote control for a cable television convertor or satellite television receiver. Krisbergh '649 column 1, lines 5-10. Krisbergh's combination handset shows a plurality of keys with a switch for placing the plurality of keys into telephone mode or appliance control mode (i.e. television controller mode). Krisbergh '649 column 3, lines 49-52. In appliance control mode, Krisbergh's device controls the television convertor box. Ibid., column 3, lines 65-66. Most important, the telephone mode operates by transmitting radio frequency signals whereas in appliance mode the device transmits infrared signals. Ibid., column 3, lines 10-14.

The Krisbergh '649 system stores telephone numbers of incoming and outgoing calls in the television convertor and displays the numbers on a television screen. Krisbergh '649 column 3, lines 1-10.

Thus, Krisbergh '649 evaluated as a whole is a combination device that operates on the principle of two separate modes, a telephone mode and appliance mode with a switch for placing the device in one mode or the other.

Nowhere does Krisbergh '649 teach or suggest a television gateway comprising a message control interface responsive to input signals for controlling at least one message having address information to associate the message with at least one user and an output module adapted to generating video frame signals corresponding to the message and constructed to deliver the signal to a terminal corresponding to the address information for display on a television set coupled thereto wherein the message control interface is constructed to control the message

responsive to user input signals entered via telephone to which claims 93 and 129 are *inter alia* directed.

In other words, Krisberg '649 fails to teach or suggest a system with which a user uses a telephone to select or otherwise control a message for display on a television associated with a terminal with a particular address.

Krisbergh et al. (U.S. patent number 5,999,970)

Krisbergh '970 shows an access system and method for providing interactive access to an information source through a television distribution system. Krisbergh '970 Abstract. Access to the internet is provided through a cable television distribution system in Krisbergh '970. Ibid., column 1, lines 10-12.

Krisbergh '970 shows a system in which all terminals on the downstream channel receive all downstream packets. A particular terminal ignores the contents of the downstream packet if the packet's session ID does not correspond to the session ID of the terminal. Krisbergh '970 column 10, lines 18-23.

An embodiment of Krisbergh '970 shows the keyboard with an infrared (IR) transmitter for transmitting keystrokes to an IR receiver on the terminal. Ibid., column 8, lines 41-46. The keyboard may be replaced by a remote control, of a type typically employed with a terminal in a television distribution system, and having directional buttons and an execute button. Ibid., column 8, lines 52-60. Thus Krisbergh '970 shows a system in which television and internet control devices are connected to the terminal using an IR transmitter and receiver.

Thus, Krisbergh '970 evaluated as a whole shows a system in which all terminals on the downstream channel receive all downstream packets and the system is controlled by an IR remote.

Nowhere does Krisbergh '970 teach or suggest a television gateway comprising a message control interface responsive to input signals for controlling at least one message having address information to associate the message with at least one user and an output module adapted to generating video frame signals corresponding to the message and constructed to deliver the signal to a terminal corresponding to the address information for display on a television set to which claims 93 and 129 are *inter alia* directed.

Nowhere does Krisbergh '970 teach or suggest a message control interface constructed to control a message responsive to user input signals entered via a telephone to which claim claims 93 and 129 are directed *inter alia*.

In other words, Krisberg '970 fails to teach or suggest a system with which a user uses a telephone to select or otherwise control a message for display on a television associated with a terminal with a particular address.

### Legal Analysis

#### Prior art must teach all subject matter of the claims

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all the subject matter of the claim. M.P.E.P. §2142; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant shows below that the combination of Krisbergh '649 and Krisbergh '970 does not teach or suggest all the subject matter of independent claims 93 and 129.

#### Legal analysis of the combination of references

Krisbergh '649 shows a portable telephone handset in combination with a remote control for a cable television convertor or satellite television receiver. Krisbergh '649 column 1, lines 5-10.

Nowhere does Krisbergh '649 teach or suggest a television gateway comprising a message control interface responsive to input signals for controlling at least one message having address information to associate the message with at least one user and an output module adapted to generating video frame signals corresponding to the message and constructed to deliver the signal to a terminal corresponding to the address information for display on a television set to which claims 93 and 129 are *inter alia* directed.

Nowhere does Krisbergh '649 teach or suggest a message control interface constructed to control a message responsive to user input signals entered via a telephone to which claim claims 93 and 129 are *inter alia* directed.



Krisbergh '970 shows a system in which all terminals on the downstream channel receive all downstream packets and a particular terminal will ignore the contents of the downstream packet if the packet's session ID does not correspond to the session ID of the terminal. .  
Krisbergh '970 column 10, lines 18-23.

It would have been known to one of ordinary skill in the art of messaging and computer programming at the time the invention was made, that sending messages to "all terminals" and having the terminals select those packets that match the current login does not teach or suggest directing messages to a terminal corresponding to address information as is the subject matter of the present claims. In fact Krisberg '970 teaches away from directing messages to a terminal corresponding to address information. In Krisbergh '970 the message is selected by the terminal. In contrast, claims 93 and 129 are directed to delivery to a specific address by the messaging system.

Nowhere does Krisbergh '970 teach or suggest a television gateway comprising a message control interface responsive to input signals for controlling at least one message having address information to associate the message with at least one user and an output module adapted to generating video frame signals corresponding to the message and constructed to deliver the signal to a terminal corresponding to the address information for display on a television set to which claims 93 and 129 are *inter alia* directed.

Nowhere does Krisbergh '970 teach or suggest a message control interface constructed to control a message responsive to user input signals entered via a telephone to which claims 93 and 129 are directed *inter alia*.

In other words, neither Krisberg '649 nor Krisberg '970 teach or suggest a system by which a user can use a telephone to select or otherwise control a message for display on a television associated with a terminal with a particular address.

The combination of Krisbergh '649 and Krisberg '970 fails to render obvious the subject matter of claims 93 and 129 because these references when combined do not teach or suggest all of the subject matter of the claims, as required by M.P.E.P. §2142. Therefore a *prima facie* case of obviousness has not been made.

Claims 99 and 130 depend from claim 93 and 129 respectively and incorporate all of the subject matter of claim 93 and 129 respectively and contain additional subject matter. As the

combination of Krisbergh '649 and Krisbergh '970 fails to render obvious the subject matter of claims 93 and 129, therefore claims 99 and 130 also are not obvious in view of Krisbergh '649 and Krisbergh '970, alone or in combination.

Applicant respectfully requests withdrawal of rejection of claims 93, 99, and 129-130 under 35 U.S.C. §103(a).

Legal Analysis of motivation to combine the references

It is well established that a proposed modification or combination of prior art references which would change the principle of operation of the prior art invention being modified is not sufficient to render the claims *prima facie* obvious. M.P.E.P., §2143.01, p. 138; *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Applicant shows below that there would have been no motivation to have combined Krisberg '649 and Krisberg '970 to have arrived at the subject matter of the present claims at the time the present application was filed, because such a combination would have required a change in the principle of operation of Krisberg '649 or that of Krisberg '970.

According to the factual analysis above, Krisbergh '649 is a combination device which operates on the principle of two separate modes, a telephone mode using radio frequencies and an appliance mode using infra red frequencies with a switch for placing the device in one mode or the other. Thus Krisberg '649 shows a device operating on a principle of two separate modes with two separate transmitters, IR for appliance mode, RF for telephone mode audio, and a physical switch to place the device in one mode or the other.

Factual analysis above further shows that Krisbergh '970 is a system in which the remote control device can be used to select television channels or can be used to operate the internet without selecting a switch to change between modes on the device.

As in *In re Ratti* where the prior art required rigidity whereas the claimed invention required resiliency, the device in Krisberg '649 has two separate modes with a switch to put the device in appliance or telephone mode whereas the system in Krisberg '970 has a single mode that allows a user to operate the television or the internet. To have combined these two references would have required eliminating Krisberg '649's use of a device with two separate modes, which is the central principle of operation in Krisberg '649. To have combined Krisberg

'649 with Krisberg '970 would have required a change in principle of operation of Krisberg '649 to transmission of telephone audio by infra red frequency, which Krisberg '649 specifically teaches away from. Krisberg '649, column 7, lines 61- 64. Therefore, there would have been no motivation to have combined these references as such a combination would have required a change in the principle of operation of either Krisberg '649's or Krisberg '970's device.

The combination of Krisbergh '649 and Krisberg '970 fails to render obvious the subject matter of claims 93 and 129 because combining the prior art would have required changing the principle of operation of the devices in these references.

Claims 99 and 130 depend from claim 93 and 129 respectively and incorporate all of the subject matter of claim 93 and 129 respectively and contain additional subject matter. As the combination of Krisbergh '649 and Krisbergh '970 fails to render obvious the subject matter of claims 93 and 129, therefore claims 99 and 130 also are not obvious in view of Krisbergh '649 and Krisbergh '970, alone or in combination.

Applicant respectfully requests withdrawal of rejection of claims 93, 99, and 129-130 under 35 U.S.C. §103(a) in view of Krisberg '649 and Krisberg '970.

Claims 94-98, 100, and 131 comply with 35 U.S.C. §103(a)

The Office action on page 12, paragraph 8 rejects claims 94-98, 100, and 131 under 35 U.S.C. §103(a) in view of Krisbergh '970 in combination with Krisbergh '649 and Krueger et al., U.S. patent number 6,460,075.

Applicant respectfully traverses the rejection.

For the convenience of the reader prior to analyzing the cited references, Applicant here reviews the subject matter of independent claims 93 and 129.

Claims 94-98 and 100 depend from claim 93, and incorporate all of the subject matter of claim 93 and contain additional subject matter. Claim 93 is directed *inter alia* to a television messaging gateway for handling messages, operating in conjunction with a television distribution system having a downstream network carrying signals to a plurality of terminals, an upstream network constructed to deliver user input signals, the television gateway comprising a message control interface responsive to input signals for controlling at least one message having address information to associate the message with at least one user and an output module adapted to

generating video frame signals corresponding to the message and constructed to deliver the signal to a terminal corresponding to the address information for display on a television set coupled thereto wherein the message control interface is constructed to control the message responsive to user input signals entered via telephone. In other words, claim 93 is directed to a television messaging gateway with which a user can use a telephone to select or otherwise control a message for display on a television associated with a terminal with a particular address.

Claim 131 depends from claim 129, and incorporates all of the subject matter of claim 129 and contains additional subject matter. Claim 129 is directed *inter alia* to a system for handling messages, operating in conjunction with a television distribution system having a downstream network carrying signals to a plurality of terminals, an upstream network constructed to deliver user input signals, the television gateway comprising a message control interface responsive to input signals for controlling at least one message having address information to associate the message with at least one user and an output module adapted to generating video frame signals corresponding to the message and constructed to deliver the signal to a terminal corresponding to the address information for display on a television set coupled thereto wherein the message control interface is constructed to control the message responsive to user input signals entered via telephone. In other words, claim 131 is directed to a system by which a user can use a telephone to select or otherwise control a message for display on a television associated with a terminal with a particular address.

Krisberg '649 and Krisbergh '970 are characterized above.

Krueger et al. (U.S. patent number 6,460,075)

Krueger shows a browser-based email system having a thin client connected to a host mail server. Krueger et al. column 1, lines 65-66. The thin client implements a browser. Ibid., column 1, lines 66-67. The thin client is equipped with a microphone and video input to receive audio and video data which the thin client can capture for inclusion with email messages. Ibid., column 2, lines 5-10.

The system further includes a set-top box having a television tuner and standard network interface devices to enable simultaneous viewing of both television programs and web programming. Ibid., column 2, line 65 – column 3, line 1.

In Krueger's system the clients and servers connect to the Internet via conventional means, such as direct-dial telephone or ISDN (Integrated Services Digital Network). Ibid., column 3, lines 13-15.

Nowhere does Krueger teach or suggest a message control interface constructed to control a message responsive to user input signals entered via a telephone, to which claims 93 and 129 are *inter alia* directed. In other words, nowhere does Krueger teach or suggest a system by which a user can use a telephone to select or otherwise control a message for display on a television associated with a terminal with a particular address.

#### Legal Analysis

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all the subject matter of the claim. M.P.E.P. §2142; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As shown in the analysis above, the combination of Krisbergh '649 and Krisbergh '970 fails to render obvious the subject matter of claims 93 and 129 because the prior art references when combined do not teach or suggest all of subject matter of the claims, as required by the M.P.E.P. §2142.

Krueger does not cure the deficiencies of Krisbergh '649 and Krisbergh '970 because, like these two references, Krueger does not teach or suggest a message control interface constructed to control a message responsive to user input signals entered via a telephone, to which claims 93 and 129 are *inter alia* directed.

As Krueger does not correct the deficiencies of Krisbergh '649 in combination with Krisbergh '970, therefore a *prima facie* case of obviousness has not been made.

Claims 94-98 and 100 depend from claim 93, and incorporate all of the subject matter of claim 93 and contains additional subject matter. As the combination of Krisbergh '649, Krisbergh '970 and Krueger fails to render obvious the subject matter of claim 93, therefore claims 94-98 and 100 also are not obvious in view of Krisbergh '649, Krisbergh '970 and Krueger, alone or in combination.

Claim 131 depends from claim 129, and incorporates all of the subject matter of claim 129 and contains additional subject matter. As the combination of Krisbergh '649, Krisbergh '970 and Krueger fails to render obvious the subject matter of claim 129, therefore claim 131 also is not obvious in view of Krisbergh '649, Krisbergh '970 and Krueger, alone or in any combination.

For any of the above reasons, Applicant respectfully requests withdrawal of rejection of claims 94-98, 100, and 131 under 35 U.S.C. §103(a).

Claims 120 and 121

The Office action on p. 2, paragraph 3 rejects claims 120 and 121 under 35 U.S.C. §102(b) in view of Checco, U.S. patent number 5,859,898.

Claims 120 and 121 were cancelled in the Amendment filed with the Request for Continued Examination submitted by Applicant on June 28, 2005, therefore this rejection is moot. Applicant respectfully requests that rejection of claims 120 and 121 under 35 U.S.C. §102(b) be withdrawn.

09/484,730

Response to 12-14-2005 Office action

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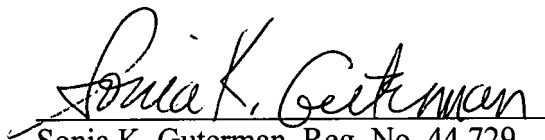
Date of deposit: October 23, 2007

Summary

On the basis of the foregoing reasons, Applicant respectfully submits that the pending claims are in condition for allowance, which is respectfully requested.

If there are any questions regarding these remarks, the Examiners are invited and encouraged to contact Applicant's representative at the telephone number provided.

Respectfully submitted,

A handwritten signature in cursive script, reading "Sonia K. Guterman", is written over a horizontal line.

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